



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,509	10/31/2003	Robert H. Wollenberg	T-6298B (538-61)	3591
7590	04/19/2006			EXAMINER CHRISTENSEN, RYAN S
MICHAEL E. CARMEN, ESQ. M. CARMEN & ASSOCIATES, PLLC 170 Old Country Road Suite 400 Mineola, NY 11501			ART UNIT 2856	PAPER NUMBER

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/699,509	WOLLENBERG ET AL. <i>pw</i>
	<b>Examiner</b>	<b>Art Unit</b>
	Ryan Christensen	2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 21 February 2006.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-18 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 8-12 is/are allowed.  
 6) Claim(s) 1-7, 13 and 14 is/are rejected.  
 7) Claim(s) 15-18 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 26 October 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>2/21/06, 12/27/05</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Response to Arguments***

Applicant's arguments filed 2/21/2006 have been fully considered but they are not persuasive.

Applicant argues Carrick et al. disclose a lubricating oil composition, and that different compositions can be individually be tested. Applicant contends there is no disclosure or suggestion of a high throughput method for screening a plurality of lubricating oil compositions by measuring wear stability of each sample to provide wear stability data of each sample, under program control. Specifically, Applicant argues there is no disclosure or suggestion of a "high throughput" method of screening oil lubricants. In response to applicant's arguments, the recitation "high throughput" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., automated method that rapidly prepares and analyzes lubricating compositions) are not recited in claim 1. Although the claims are interpreted in light of

the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). High throughput method is not explicitly defined in the claims as automated method that rapidly prepares and analyzes lubricating compositions.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pre-Grant Publication 2002/0147116 (Carrick).

With respect to claim 1, Carrick discloses a plurality of different lubricating oil composition samples comprising a major amount of at least one base oil of lubricating viscosity and a minor amount of at least one lubricating oil additive (Unlabeled Table, Pages 17-19); measuring wear stability of each sample to provide wear stability data for each sample (unlabeled table, pages 17-19 and pg. 17, paragraphs 183 – 197); and, outputting the results (unlabeled table, pages 17-19).

With respect to claim 2, Carrick discloses the limitations of claim 1 wherein the step of measuring wear stability is selected from the group consisting of an extreme pressure wear test hydrodynamic wear test, corrosive wear test and a combination thereof (page 17, paragraphs 183 – 197).

Art Unit: 2856

With respect to claim 3, Carrick discloses the step of measuring wear stability further comprises the step of selectively changing a variety of conditions for measuring wear stability in accordance with the program control, the variety of conditions being selected from the group consisting of duration of the at least one test, load generated during the at least one test, acid amount delivered during the at least one test and a combination thereof (pg.17, paragraph 185).

With respect to claim 4, Carrick discloses the extreme pressure, hydrodynamic and corrosive wear test are conducted simultaneously in accordance with the program control (pg.17, paragraph 185).

With respect to claim 5, Carrick discloses the extreme pressure, hydrodynamic and corrosive wear test are conducted sequentially in accordance with the program control (pg.17, paragraph 185).

With respect to claim 6, Carrick discloses wherein the corrosive wear test is conducted simultaneously with at least one of the extreme pressure and hydrodynamic tests in accordance with the program control (oxidizing agent, pg.17, paragraph 185).

With respect to claim 7, Carrick discloses further comprising the step of systemizing the outputted results of each of the extreme pressure, hydrodynamic and corrosive wear tests, thereby assembling a library of the outputted results associated with each of the plurality of lubricating oil compositions, wherein each one of the wear tests is selected to be indicative of performance of a selected part of or an entire running internal combustion engine (unlabeled table, pages 17-19 and pg. 17, paragraphs 183 – 197).

With respect to claim 13, Carrick discloses at least one lubricating oil additive is selected from the group consisting of antioxidants, anti-wear agents, detergents, rust inhibitors, dehazing agents, demulsifying agents, metal deactivating agents, friction modifiers, pour point depressants, antifoaming agents, co-solvents, package compatibilisers, corrosion-inhibitors, ashless dispersants, dyes, extreme pressure agents and mixtures thereof (unlabeled table, pages 17-19).

With respect to claim 14, Carrick discloses further comprising the step of displacing the plurality of lubricating oil compositions to a testing station configured to provide at least one of the extreme pressure wear stability test, hydrodynamic wear test, and the corrosive wear test to determine anti-wear properties of each of the tested lubricating oil compositions in accordance with the program control (paragraphs 183-185).

#### ***Allowable Subject Matter***

Claims 8-12 are allowed.

Claims 15-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 6,840, 082 (Evans) discloses an apparatus for high pressure and hydrodynamic testing of oil compositions with automated load control.

U.S. Patent Publication 2003/0123650 (Kolosov) discloses a method of screening a plurality of compositions where a probe is actuated with a robotic arm.

U.S. Patent 3,526,127 (Sakis) discloses a method for running a plurality of tests on a large number of oil samples and generating an automated analysis.

U.S. Patent 4,209,414 (Holgado) discloses selectively changing the pressure and duration of a tests run on oil compositions.

U.S. Patent 6,235,691 (Boffa) discloses high load and temperature testing of oil compositions.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

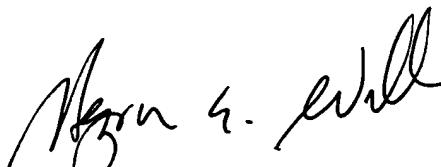
Art Unit: 2856

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Christensen whose telephone number is 571-272-2683. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on 571-272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RC



HEZRON WILLIAMS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800